Supreme Court, U.S.
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(3)

No. 04-1649

In the Supreme Court of the United States

LUIS A. SORO,

Petitioner,

v.

CITICORP,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

1. Whether the May 24, 2003 decision by the District Court to hold Petitioners Luis Soro and Citicorp Mortgage Co., Inc. in contempt of the permanent injunction entered on October 6, 1988 raises any novel or important issues to justify review by this Court

PARTIES TO THE PROCEEDINGS

The following are the parties to this proceeding:

Petitioners Luis A. Soro and Citicorp Mortgage Company, Inc.

Respondent Citicorp

CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 29.6, Respondent Citicorp hereby states that the only parent corporation or publicly held company that owns 10% or more of Citicorp stock is Citigroup Inc.

TABLE OF CONTENTS

QUESTION PRESENTED i

PARTIES TO THE PROCEEDINGS ii

CORPORATE DISCLOSURE STATEMENT ii

TABLE OF CONTENTS iii

TABLE OF AUTHORITIES iv

CITATIONS OF OFFICIAL AND UNOFFICIAL REPORTS OF THE OPINIONS AND ORDERS ENTERED IN THIS CASE 1

THE COURT SHOULD DENY THE WRIT 2

CONCLUSION 4

TABLE OF AUTHORITIES

CIT Group, Inc. v. Citicorp,
20 F. Supp. 2d 775 (D.N.J. 1998) 2

Citigroup, Inc. v. City Holding Co.,
171 F. Supp. 2d 333 (S.D.N.Y. 2001) 2

CITATIONS OF OFFICIAL AND UNOFFICIAL REPORTS OF THE OPINIONS AND ORDERS ENTERED IN THIS CASE

1. *Citicorp v. Citicorp Mortgage Co.*, No. 85-CV-2960 (S.D. Fla. Oct. 6, 1988), Summary Final Judgment, *aff'd*, 898 F.2d 158 (11th Cir.), *cert. denied*, 498 U.S. 854 (1990).

2. *Citicorp v. Citicorp Mortgage Co.*, 940 F.2d 1541 (11th Cir. 1991), *cert. denied*, 502 U.S. 1059 (1992).

3. *Soro v. Citicorp, cert. denied*, 508 U.S. 961, *reh'g denied*, 509 U.S. 945 (1993).

4. *Citicorp v. Citicorp Mortgage Co.*, No. 85-CV-2960, Report Recommending That The Plaintiff Motion To Find Luis Soro In Contempt Be Granted (S.D. Fla. Mar. 26, 2003).

5. *Citicorp v. Citicorp Mortgage Co.*, Order Adopting Magistrate Report & Recommendation And Granting Plaintiff Motion To Find Defendant Luis Soro In Contempt Of Court (S.D. Fla. May 14, 2003).

6. *Citicorp v. Citicorp Mortgage Co.*, *aff'd*, No. 04-11757 (11th Cir. Nov. 2, 2004) (per curiam), *reh'g en banc denied* (11th Cir. Dec. 21, 2004).

THE COURT SHOULD DENY THE WRIT

The Petition for a Writ of Certiorari should be denied for two fundamental reasons: (i) there is no conflict among the circuits as to a question of law, much less an important one needing resolution, and (ii) none of the issues in any way involve unsettled issues of law. Rather, the dispute in this case relates solely to the rights of and between the parties. Petitioners have had a full and fair hearing in the courts below. Their only grievance is that they lost.

Respondent Citicorp is one of the leading financial services providers in the United States, and indeed the world. As of 2000, Citicorp had received or applied for federal registrations for approximately 140 marks containing the word CITI, including CITI, CITICORP, and CITIGROUP. Its famous family of CITI marks has been recognized by federal courts. *See, e.g., Citigroup, Inc. v. City Holding Co.*, 171 F. Supp. 2d 333, 353 (S.D.N.Y. 2001); *CIT Group, Inc. v. Citicorp*, 20 F. Supp. 2d 775, 793 (D.N.J. 1998).

In 1985, Citicorp sued a Florida entity named Citicorp Mortgage Company, Inc. ("Citicorp Mortgage") for trademark infringement and unfair competition, and in 1987, Citicorp amended its Complaint to include as a defendant that entity's principal, Luis Soro. The district court granted summary judgment to Citicorp, and issued a Permanent Injunction (the "Injunction") against Mr. Soro and Citicorp Mortgage, prohibiting them from using the mark CITICORP or any other name or mark confusingly similar to CITICORP, in connection with any business which Defendants conduct, own, or control. That Injunction was affirmed by the United States Court of Appeals for the Eleventh Circuit in 1990, and a petition for certiorari was denied.

More than twelve years after entry of the Injunction, Mr. Soro filed in the United States Patent and Trademark Office Trademark Trial and Appeal Board a Petition to Cancel Citicorp's newly registered CITIGROUP mark. In his Petition to Cancel, Soro claimed that he was a prior user of the mark CITIGROUP in connection with his mortgage business. Based on documents produced by Mr. Soro in discovery during the Cancellation Proceeding, demonstrating his recent use of the name "Citigroup" for a mortgage business, Citicorp moved to reopen the 1985 lawsuit and moved for an order finding Soro in contempt for violating the Injunction. After a hearing before a Magistrate Judge at which Soro appeared personally, testified, and submitted documentary evidence, the District Court granted Citicorp's motion.

The fundamental issues litigated in this proceeding were: (i) whether a trademark used for mortgage services, CITIGROUP, which Soro claims to have coined but whose testimony on that subject the District Court found not to be credible, was confusingly similar to the mark CITICORP, and (ii) whether the long-established safe distance doctrine was applicable, such that the District Court was correct to hold that, having previously been enjoined, Soro failed to stay a safe distance from CITICORP by using the mark CITIGROUP for similar or identical services.

The legal doctrines at issue in the courts below are well-established. Their application to Petitioner required no new legal principles, only the application of clear precepts to the facts before the District Court. There is nothing in the record that would possibly justify review by this Court.

CONCLUSION

The Petition for a Writ of Certiorari should be denied.

Dated: June 30, 2005

Respectfully submitted,

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4

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CITICORP MORTGAGE COMPANY INC., &
LUIS SORO

Petitioner,

v.

CITICORP

Respondents.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
For The Eleventh Circuit

PETITION FOR REHEARING

Luis Soro President
CITICORP MORTGAGE CO. INC.,
INVENTOR, CREATOR, DESIGNER.
FABRICATOR, DEVELOPER,
CULTIVATOR, AND THE FIRST
USER OWNER SINCE JANUARY 05,
1976 THE TRADENAME CITIGROUP
MORTGAGE COMPANY
P,O, Box 398142
Miami Beach, Fl. 33239-8142

(305) 354-4573

TABLE OF AUTHORITIES

	Page
Continental Bank Corp v. The State of Florida Supreme Court 87-1955	10
Delaware & H. Canal Co. v. Clark 13 Wall. 311, 322, 20 L.ed. 681, 583	10
Fidelity Bond & Mortgage Co. v. Fidelity Bond & Mortgage Co. Texas	10
First Souther Federal Savings First Southern Savings	10
Mclean v. Fleming 96 U.S. 245,254, 24 L.2d. 828, 832	10
Moseley v. V Secret Catalogue 123 S. Ct. 1115 (Mar. 04, 2003)	10
Sun Banks of Florida Inc., v. Sun Federal Savings & Loan 651 F.2d. 331 (5th Cir. 1981)	10
Surf Club v. Tatem Surf Club Inc., 151 Fla. 405, 10 So. 2d. 554 (1942	10
Statutes and Rules:	
37 C.F.R. § 10.14 (e)	6
Fed. R. Civ. P. 52 (e)	8

PETITION FOR REHEARING

Pititioner Respectfully requests a rehearing in this case because he has not recieved a jury trial since 1985. This Petitioner has not recieved any type of trial after Respondent's illegal entry into the state of Florida in 1984 because they are a bank holding company. This Petitioner has been requesting a jury trial to present all the case facts and evidence.

In January 1976 this Petitioner went to the President of a Federal Insured Savings Bank Citi zens Federal Savings and Loan and asked permission to use the name Citigroup because Petitioner was doing mortgage business with South America and funding the loans with Citizens Federal Bank. The President of Citizens Federal did not see any conflict with Pititioner's use of Citigroup and Citigroup mortgage Co. and granted the request. On July 7, 1981 this Petitioner incorporated Citicorp Mortgage Company Inc. another company he had formed on December 15, 1979, to als. do business with Citizens Federal and other bank, and because they were the initials of former girl friends.

Petitioner invented, fabricated, manufactured, created and is the first original user owner of a name that is not found in the dictionary and has been used in interna. nal and intersta and commerce since nuary 5, 1976 with undisputed ultimate rights. All the Pititioner is asking for with this

petition is a fair jury trial to be able to show a jury all the facts and evidence about this case. (CITIGROUP)

In trademark case law the inventor or creator of a name has undisputed ultimate rights to that name. Petitioner had the permission from the President of Citi zens Federal a bank formed in the 1940's to use the tradename Citigroup and this Petitioner has found over (2000) two thousand citi users since 1976. Respondent should not be permitted to restrict this Petitioner from using his invented name and mark Citigroup and Citicorp Mortgage Company Inc., without a jury trial.

This Petitioner Respectfully moves this Honorable Court to review the following and at least grant a jury trial to present the following evidence and case facts to a jury. These are just a number of the companies that use citi in their name that have been found since 1976:

CIT GROUP, CITI FIRST CAPITAL, CITI LOANS, CITI CASH, CITICASH LOANS, CITIPAWN LOANS, CITITOTAL MORTGAGE, CITITRUE MORTGAGE, CITICOMPLETE MORGAGE, CITITREE LOANS, CITI TO GO LOANS, CITI ZENS MORTGAGE, CITIZENS LOANS, CITIZEN FEDERAL SAVINGS, CITIZENS PAWN, CITIZENS FIRST AND SECOND MORTGAGE, CITIZEN VALUE LOAN, CITI CENTER LOANS, CITIZENS CENTER LOANS, CITIWIDE MORTGAGE, CITIGATE MORTGAGE, CITITRUST MORTGAGE, CITIZENS FINANCIAL, CITI MORTGAGE LENDERS, CITI INVESTMENT GROUP, CITI HOME LOANS, CITIHOME MORTGAGE, CITIONE MORTGAGE, CITI INVESTMENT LOANS,

CITINATIONAL MORTGAGE, CITILENDING CORP, CITIMORTGAGE BROKERS, CITINEW MORTGAGE, CITIFIRST TRUST MORTGAGE, CITICONSUMER MORTGAGE, CITILINE HOME MORTGAGE, CITILINE MORTGAGE, CITIKEY MORTGAGE, CITISIDE HOME MORTGAGE, CITISPEED MORTGAGE, CITIKEY HOME LOANS, CITI PROPERTY MORTGAGE, CITI PROTECTED MORTGAGE, CITI POWER HOME MORTGAGE, CITISKY MORTGAGE, CITICODE MORTGAGE, CITIPOWER MORTGAGE, CITIBID MORTGAGE, CITI DISCOUNT MORTGAGE, CITI OUTLET MORTGAGE, CITIHOME IDEAL MORTGAGE, CITI INDUSTRY MORTGAGE. CITI INDEPENDENT MORTGAGE, CITISMART HOME MORTGAGE, CITI SERCH MORTGAGE, CITI CAPIAL MORTGAGE, CITIHOME IMPROVEMENT LOANS, CITIPERFECT MORTGAGE, CITIDREAM MORTGAGE, CITIADVANTAGE MORTGAGE,CITI AMERICAN MORTGAGE, CITIACTIVE LOANS, CITIPHONE MORTGAGE, CITIPARTNER HOME MORTGAGE, CITIEQUITY LOANS, CITIHOME APPROVED MORTGAGE, CITIMUTUAL MORTGAGE, CITIHABITAT MORTGAGE, CITI HOUSING LOANS, CITIBLOCK MORTGAGE, CITI COMMERCIAL MORTGAGE, CITI LOWEST MORTGAGE, CITI AFFORDABLE MORTGAGE, CITISTARS LOANS CITIBAY MORTGAGE, CITIBEST MORTGAGE FUNDING, CITICHOICE MORTGAGE, CITI ADVISORS MORTGAGE, CITIBELL LOANS, CITICOAST MORTGAGE, CITICIRCLE LOANS, CITIHILL MORTGAGE, CITISTARS MORTGAGE, CITIBROOKS MORTGAGE, CITICIRCLE MORTGAGE, CITIBELL MORTGAGE, CITIEAST MORTGAGE, CITI COMMERCIAL LOANS.

This Petitioner has many more

citi users since 1976 and will prove to this Honorable Court that similar names are used in every type of business. This Petitioner has ultimate undisputed rights to his invented name Citigroup since 1976.

Please see: MICROSOFT, MICROTOOL, MICRO TEL, MICROTEC, MICROSHARP, MICROFAX, MICROSOURCE, MICROSHRED, MICROSECURITY, MICRO SERVICES, MICROSCOPE, MICROBUSINESS, MICRO AMERICA, MICROBOL, MICROLAB.

Please also see: Bank of New York, Bank of Miami, Bank of Coral Gables, Bank of Nevada, Bank of Florida, Bank of Utah, Bank of Colorado, Bank of Washington, Bank of Ohio, Bank of Japan, Bank of Iowa, Bank of London, Bank of Canada, Bank of America, Bank of Hollywood, Florida, Bank of Hollywood, California, Bank Atlantic, Atlantic Bank. The First part of a name a company uses, does not mean that they are part of or associated with a company with a similar name. Please see Wal-Mart, Wal-Greens, Yellow Pages, and yellow Book, also GoodYear Tires, Good Rich Tires, GoodRick Tires, GoodMan Tires, Goodstine Tires, Goodway Tires, Goodhart tires, Goodall Tires, Goodfellow Tires, Goodspeed Tires, Goodson Tires, Goodwin Tires, Goodware Tires, Goodin Tires.

Respondent is trying to hijack this Petitioner's invented name that is almost (30) thirty years old, 3 decades of first user undisputed rights with unpublished opinions and over $61,000.00 in legal fees in this (20) twenty year old case.

STATEMENT OF THE CASE

A. Summary of Facts

Defendant Luis Soro is the registered and licensed president and sole shareholder of the licensed and registered Defendant Citicorp Mortgage Company Inc., since it was incorporated on July 07, 1981, a licenced mortgage broker and owner since it was formed on December 15, 1979.

Defendant Luis Soro is the creator, inventor and the original first user owner of Citigroup Mortgage Company since it was manufactured on January 05, 1976 and has never been incorporated to this date.

Defendant Luis Soro made his first mortgage loan over (40) forty years ago on March 1965 and has made over 15,000 loans since, over 10,000 ten thousand mortgage loans using the Citigroup tradename since 1976 through the world.

On or about 1984 Respondend entered the Petitioners state of Florida inviolation of both federal and state of Florida banking rules to save a failed savings and loan

Biscayne Federal. On or about August 1985 Respondent sued the Pititioner for trademark infringment for using a name that was invented (8) eight years prior Respondent entered the state of Florida. This is a trademark case, and rule 37 CFR 10.14 (e), if a party electing to represent itself is a corporation or an association, the party may act through any individual who is an officer of the party and who is authorized to represent it. I Luis Soro was not permitted to file any papers to defend my corporation in this trademark case in violation of rule 37 CFR 1014 (e), and nothing was ever said about one of my other companies Citigroup Mortgage Company.

The violation of rule 37 CFR 10.14 (e) resulted in a summary Judgment without a jury trialand this case ended. On or about October 08, 1998 Respondent started using one of Petitioners (22) twenty two year old tradename Citigroup. Pititioner filed a cancellation case number 31,572 at the United States Patent and Trademark office on November 22, 2000, one (1) day after the Respondent fraudulently registered my mark on November 21, 2000.

The tradename Citigroup invented and cultivated by Luis Soro that did not mean anything until I gave it a meaning is as close to Respondent's mark Citicorp as Wal-Mark is to Wal-Greens, Goodyear tires is to Goodrich tires, General Motors is to General tires to General Electric, to General Mills to General Rental, to General Nutrition, American Airlines to American Express,— American Cargo Express, American Red Cross, to American Coin Exchange to American Cancer Society, to American Heart Association.

The name citigrada and citigrade are found in the dictionary that have nothing to do with Respondent or Petitioner. The Petitioner has found over (2000) two thousand "citi" users since 1976 all over the United States and beyond, that have nothing to do with the Respondent or the Pititionerand the lawyer for the Respondent agree with the Pititioner that "citi use is not new". Pititioner has innumerable (∞) business owners that use the mark cities, city, citi, or cit in their tradenames have been found.

The word city or cities is a noun, it discribes a place or thing, phoneticly cities is the plural of city, and the undisputed facts that we have traditionaly tolorated

a greater degree of resemblence anoung the names of financial institutions only reinforces this conclusion.

This Supreme Court of the United States recognized over (70) seventy years ago that there is no such thing as a property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed. Use it or lose it should be a guiding principal for trademark owners, and the right to a particular mark grows out of use, not its mere adoption.

The Honorable Joan A. Leanard wrote in her opinion "as it is undisputed that Soro has been using the name Citigroup name since at least the mid 1990's..based on case facts, meaning 1994-1995 giving Luis Soro "FIRST USE" The district court misapprehended the law and that is reviewed under the clearly erroneous standerd of Fed. R. Civ. P. 52 (e).

Respondent's own attorney in a signed declaration and after being warned that willful false statements and the like so made were punishable by fine or imprisonment

or both under U.S.C. § 1001, and that such willful false statements my jeopardize the validity of this document, Stated on June 15, 2000 "the mark was first used on the goods or services anywhere at least as early as April 6, 1998 and in commerce at least as early as October 8, 1998". Signed by Anne Moses, Assistant Secetary.

The Eleventh Circuit rejected Luis Soro's repeated claims that he was the first user of the mark "Citicorp" and had a right to the term. They also wrote "these contentions are not relevant to the issue of this case". First use is very relevant to a trademark case because first use or senior use gives ultimate rights to the use of that particular mark. Use is not only essential to establishing rights in a particular mark, continued use is essential to preserving rights in a mark.

In determining likelihood of confusion service marks, similarty of appearance is determined on the basis of the total effect of the designation rather that on a comparison of the individual features, between service marks,and a federal registration is not need for a service mark to establish rights.

Pititioner has twenty two (22) years prior use of his invented tradename before Respondent hijacked the mark Citigroup on October 8 1998.

REASONS FOR GRANTING THE PETITION

A. Summary of Argument

The Eleventh's Circuit opinion in this case is a study in contradiction and an utter rejection of this Court's and other court's clearly established principals of trademark and First Amendment law. See Moseley v. V. Secret Catalogue Inc. 123 S. CT. 1115 (Mar. 04, 2003).

It is a well established law that first user or inventor or creator has the the ultimate rights to that name. It is also a well established and undisputed facts that we have traditionaly tolorated a greater degree of resemblence amon g the names of financial institutions. Sun Banks v. Sun Federal 651 F.2. 331 (5th Cir. 1981), First Southern Federal v. First Southern Savings 614 F.2d. 71 (5th Cir. 1980), Fidelity Bond v. Fidelity Bond (37 F.2d 99 (5th Cir. 1930). Del v. Clark

While both Appellants and Appellees in this case for almost (20) twenty years have been in litigation it must come to an end at some point, and that point is now. Continental Bank v. State of Fl. S.Ct. Home Savings v. Home Saving of America. The lower court judge agree with this Petitioner he was the first Citigroup user.